

**REMARKS**

Claims 1-26 are cancelled. Claims 27-66 are added. Claims 27-66 are now active and under consideration.

Applicants wish to thank Examiner Russel for the recent helpful and courteous discussion conducted with their representative, Mr. William Beaumont. The following remarks are both consistent with, and elaborative upon that discussion.

**I. Rejections Under 35 USC 102(b)**

Claims 1-3, 5, 6, 11-13, 21 and 23 stand rejected under 35 USC 102(b) as being anticipated by Schally et al. (U.S. 5,258,492). However, this reference fails to disclose the claimed subject matter.

Notably, Schally et al. describe certain peptides which contain cytotoxic moieties. Clearly, this reference would have neither disclosed nor suggested to one skilled in the art that the complex compound of present claim 27 or 32 would coordinate to nickel, thereby allow such ligands to attach covalently to nucleic acids.

Thus, one skilled in the art would clearly not have been put in possession of the claimed invention by this reference.

Hence, this ground of rejection is unsustainable and should be withdrawn.

Claims 1-3, 5, 11, 12, 21 and 23 stand rejected under 35 USC 102 (b) as being anticipated by Mauclaire et al. (U.S. 5,268,371).

However, in view of the above amendments, this ground of rejection is deemed moot.

Claims 1-3, 5, 6, 11, 12, 21 and 23 stand rejected under 35 USC 102(b) as being anticipated by Burrows et al. (U.S. 5,272,056). However, this reference fails to either disclose or suggest the claimed subject matter.

In particular, this reference describes tetraazamacrocyclic ligands for nickel although salicylaldehyde derivatives are also shown. However, the latter species are not conjugated to any ligands such as biotin. Moreover, the ligands of this reference are neutral, and their solubility is very low in aqueous systems necessary, which would teach away from the disclosed activity of the present invention. While this reference alludes to “modification” of nucleic acids, no covalent attachment between the ligand of a nickel complex and DNA was foreseen thereby. Only thereafter did the present inventors demonstrate the unexpected result that salicylaldehyde derivatives could covalently attach and carry with them a label such as biotin. Thus, it is clear that this reference would not have put one skilled in the art in possession of the claimed subject matter at the time it was made.

Hence, this ground of rejection is unsustainable and should be withdrawn.

Claims 26 stands rejected under 35 USC 102(b) as being anticipated by Woodson et al. (Nucleic Acid Research, Vol. 21, pages 5524-5525).

However, in view of the above amendments, this ground of rejection is deemed moot.

Claims 1-4 and 21 stand rejected under 35 USC 102(b) as being anticipated by WO 97/10854. However, this reference fails to either disclose or suggest the claimed subject matter.

In particular, this reference discloses a wide range of metal-chelator biotin conjugates to bind paramagnetic metals and radioactive metal nuclides. This reference discloses neither the specific complex compound structures claimed, nor their ability to covalently couple to a target nucleic acid or protein.

Hence, one skilled in the art would not have been put in possession of the claimed invention at the time it was made by this reference.

Hence, this ground of rejection is unsustainable and should be withdrawn.

## **II. Rejections Under 35 USC 112 and Objections To The Specification**

Claims 1-6, 11-15, 21, 23 and 26 stand rejected under 35 USC 112, second paragraph.

However, in view of the above amendments, this ground of rejection is deemed to be moot.

Finally, the disclosure is objected to in view of the informalities noted in paragraph 3 at pages 3 and 4 of the Official Action.

However, this objection is deemed moot in view of the additional copies of the previously submitted paper copy of the sequence listing and statements required by 37 CFR 1.825(a) and (b). Specifically, these papers, required by the Examiner in paragraph 2 at page 3 of the Official Action, were originally submitted on September 27, 2005. Appropriately, a copy of the date-stamped filing receipt therefore is also submitted herewith.

**CONCLUSION**

In view of all of the above, it is believed that this application is now in condition for allowance. Early notice to this effect is earnestly solicited. Nevertheless, if any issues remain which the Examiner feels may be resolved through a personal or telephonic interview, the Examiner is respectfully urged to contact the undersigned at the telephone number listed below.

Respectfully submitted,

MERCHANT & GOULD P.C.



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**ATTACHMENT**